



1636/#
Attorney Docket No. 71745/55913

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

APPLICANTS: Neil J. Butt, et al.

SEP 04 2002

U.S.S.N.: 09/856,336

GROUP: 1636

TECH CENTER 1600/2900

FILED: 8/20/2001

EXAMINER: Sandals, William O.

FOR: Nucleic Acid Isolation

CERTIFICATE OF MAILING

I hereby certify this correspondence and the documents referred to as attached herein are being deposited with the United States Postal Service as First Class Mail addressed to Assistant Commissioner for Patents, Washington, D.C. 20231 on August 26, 2002.

By:

Regina M. Edwards
Regina M. Edwards

Commissioner of Patents
Washington, D.C. 20231

TRANSMITTAL LETTER

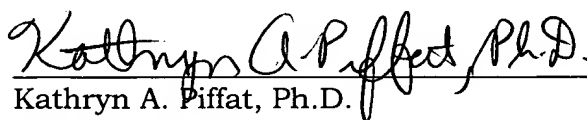
Transmitted herewith for filing in the above-referenced patent application are the following documents:

- 1) Amendment (17 pages);
- 2) Amendment Transmittal (4 pages) (x2);
- 3) Copy of Office Action of March 26, 2002;
- 4) Information Disclosure Statement;
- 5) Form 1449;
- 6) Check #708796 in the amount of \$580.00 representing the 2-month extension fee (\$400.00) and IDS fee (\$180.00);
- 7) U.S. Patent 5,637,687;
- 8) U.S. Patent 5,643,767;
- 9) Japanese Patent Application H3-101688;
- 10) English translation of Japanese Patent Application H3-101688;
- 11) Copy of International Search Report;

- 12) This Transmittal Letter (x2);
- 13) Certificate of First Class Mailing; and
- 14) Return Postcard.

The Commissioner is hereby authorized to charge any excess fees that may be required, or credit any overpayment to Deposit Account No. 04-1105. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



Kathryn A. Piffat, Ph.D.

Reg. No.: 34,901

DBRC, Intellectual Property Practice
Group of

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Date:

August 26, 2002

BOS2_311120.1



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By: Regina M. Edwards
Regina M. Edwards

Assistant Commissioner for Patents
Washington, D.C. 20231

AMENDMENT TRANSMITTAL

1. Transmitted herewith is an amendment for this application.

STATUS

2. Applicant is
☐ a small entity. A statement:
☐ is attached.
☐ was already filed.
☒ other than a small entity.

EXTENSION OF TERM

NOTE: "Extension of Time in Patent Cases (Supplement Amendments) -- If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

NOTE: See 37 C.F.R. Section 1.645 for extensions of time in interference proceedings, and 37 C.F.R. Section 1.550(c) for extensions of time in reexamination proceedings.

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. Section 1.136 apply. (complete (a) or (b), as applicable)

- (a) ☐ Applicant petitions for an extension of time under 37 C.F.R. Section 1.136
(fees: 37 C.F.R. Section 1.17(a)(1)-(4)) for the total number of months checked below:

	Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/>	one month	\$ 110.00	\$ 55.00
<input checked="" type="checkbox"/>	two months	\$ 400.00	\$ 200.00
<input type="checkbox"/>	three months	\$ 920.00	\$ 460.00
<input type="checkbox"/>	four months	\$ 1,440.00	\$ 720.00

Fee: \$ 400.00

If an additional extension of time is required, please consider this a petition therefor.
(check and complete the next item, if applicable)

- ☐ An extension for ___ months has already been secured. The fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

OR

- (b) ☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

4. The fee for claims (37 C.F.R. Section 1.16(b)-(d)) has been calculated as shown below

(Col.1)	(Col. 2)	SMALL ENTITY				OTHER THAN A SMALL ENTITY	
Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra	Rate	Addit. Fee	O R	Rate	Addit. Fee
38	35		\$9.00	\$		\$18.00	\$54.00
Independent Claims Remaining After Amendment	Independent Claims Remaining After Amendment		\$42.00	\$		\$84.00	\$
First Presentation of Multiple Dependent Claim+			\$140.00	\$		\$280.00	\$
						Total Addit. Fee	\$54.00

- * If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3,
** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".
*** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".
The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

WARNING: "After final rejection or action (Section 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. Section 1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

- (c) ☐ No additional fee for claims is required.

OR

- (d) ☒ **Total additional fee for claims required \$ \$54.00**

FEE PAYMENT

5. ☒ **Attached is a check in the sum of \$ 400.00 for 2-month ext. fee.**
☒ **Charg Account No. 04-1105 th sum f \$54.00 for claims f .**

A duplicate of this transmittal is attached.

Attorney Docket No.: 71745/55913

U.S. Serial No.: 09/856,336

Applicants: Neil J. Butt, et al.

Filing Date: August 20, 2001

Group Art Unit: 1636

Examiner: Sandals, William O.

FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).

6. [X] If any additional extension and/or fee is required, charge Account No. 04-1105.

AND/OR

- [X] If any additional fee for claims is required, charge Account No. 04-1105.

August 26, 2002


SIGNATURE OF PRACTITIONER

Kathryn A. Piffat, Ph.D.
Reg. No. 34,901
DBRC, Intellectual Property Practice
Group of Edwards & Angell, LLP
P.O. Box 9169
Boston, Massachusetts 02209

Customer No. 21874

BOS2_311103.1

55913 (1745)



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,336	08/20/2001	Neil James Butt	7174555913	6843

7590 03/26/2002

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SEP 04 2002

TECH CENTER 1600/2900

EXAMINER

SANDALS, WILLIAM O

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary



Application No.
09/856,336

Applicant(s)

Butt et al.

Examiner

William Sandals

Art Unit

1636



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 20, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 24-27 is/are rejected.
- 7) ☒ Claim(s) 5-23 and 28-35 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:



Appl 424 #5

Application/Control Number: 09/856,336

Page 2

Art Unit: 1636

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claims 5-23 and 28-35 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 5-23 and 28-35 have not been further treated on the merits.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by JP

03101688.

Art Unit: 1636

JP 03101688 taught (see the abstract) a aqueous mixture comprising a chaotrope (guanidinium salt) and butanol in a method of isolating plasmid DNA from an aqueous mixture of plasmid DNA and genomic DNA by adding a chaotrope (guanidinium salt) and butanol, then isolating the plasmid. The aqueous solution was at a basic pH.

5. Claims 1-4 and 24-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 03101688.

JP 03101688 taught (see the abstract) a method of isolating plasmid DNA from an aqueous mixture of plasmid DNA and genomic DNA by adding a chaotrope (guanidinium salt) and butanol, then isolating the plasmid. The aqueous solution was at a basic pH.

JP 03101688 did not explicitly teach that the basic pH of the solution was produced by adding sodium hydroxide. However, sodium hydroxide is a notorious and well known basic reagent used to produce a basic pH in a solution containing plasmid DNA and genomic DNA as shown in WO 99/61603 (see especially page 12).

Conclusion

6. Certain papers related to this application are ***welcomed*** to be submitted to Art Unit 1636 by facsimile transmission. The FAX numbers are (703) 308-4242 and 305-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by the applicant or applicant's representative, and the FAX receipt from your FAX machine is proof of delivery. NO

Art Unit: 1636

DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications should be directed to Dr. William Sandals whose telephone number is (703) 305-1982. The examiner normally can be reached Monday through Thursday from 8:30 AM to 7:00 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached at (703) 305-1998.

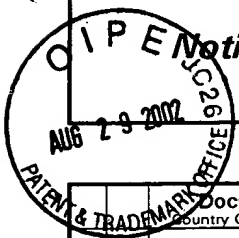
Any inquiry of a general nature or relating to the status of this application should be directed to the Zeta Adams, whose telephone number is (703) 305-3291.

William Sandals, Ph.D.

Examiner

March 24, 2002

A handwritten signature in black ink, appearing to read "William Sandals", written over the typed name and date.



Notice of References Cited

Applicant/Patent Butt et al.	Application/Control No. 09/856,336	
Examiner William Sandals	Art Unit 1636	Page 1 of 1

U.S. PATENT DOCUMENTS

	Document Number Country Code-Number-Kind Code	Date MM-YYYY ¹	Name	Classification ²	
A					
B					
C					
D					
E					
F					
G					
H					
I					
J					
K					
L					
M					

FOREIGN PATENT DOCUMENTS

	Document Number Country Code-Number-Kind Code	Date MM-YYYY ¹	Country	Name	Classification ²	
N	JP 03,101,688	4/1991	JP	Kamata et al.	435	64
O	WO 99/61603	12/1999	WO	Qiagen	536	23.1
P						
Q						
R						
S						
T						

NON-PATENT DOCUMENTS

	Include, as applicable: Author, Title, Date, Publisher, Edition or Volume, Pertinent Pages
U	
V	
W	
X	

* A copy of this reference is not being furnished with this Office action. See MPEP § 707.05(a). ¹ Dates in MM-YYYY format are publication dates. ² Classifications may be U.S. or foreign.